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Peter Ohnemus

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EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3694

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

10/708,441

**Applicant(s)**

OHNEMUS ET AL.

**Examiner**

Susanna M. Diaz

**Art Unit**

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-54 and 56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-54 and 56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152..

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 2, 2006 has been entered.

Claims 1, 3, 19, 21, 37, and 39 have been amended.

Claim 56 has been added.

Claims 1-54 and 56 are pending.

### ***Response to Arguments***

2. Applicant's arguments filed October 2, 2006 have been fully considered but they are not persuasive.

Applicant's arguments revolve around the declarations filed in support of the assertion that the claimed invention produces a useful, concrete, and tangible result in practice. While the Examiner agrees that the claim amendment has resolved the lack of usefulness for all claims, there remains the problem that the claimed invention does not convey enough detail within the claims themselves to produce a concrete result.

Regarding concreteness, the Applicant argues that the formula uses the input coefficients to yield an output (pages 17-20 of the Applicant's response) and therefore

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yields a concrete result. The Examiner agrees that there are formulas that do generate concrete results from subjective data; however, both the coefficients and the formula are so broadly recited that one cannot ascertain if the invention, as claimed, yields a result that is substantially repeatable. If Applicant's novelty is the formula itself, then the formula should be clearly set forth in the claims. However, if the Applicant's novelty lies more in the interface that allows a user to set up a benchmarking tool, then this aspect of the invention should be clarified as well.

Additionally, regarding the preemption rejection under § 101, Applicant requests "that the Examiner 'identify the abstraction...and explain why the claim covers every substantial practical application,' so that Applicants' may better focus their response." (Page 22 of Applicant's response) Again, both the coefficients and the formula are so broadly recited that it is not clear what the Applicant is asserting as the intended novelty of the claimed invention. Applicant's drawings show a few examples of possible formulas with varying sets of coefficients; however, the claimed invention is not limited to the scope of any of these specific examples. Consequently, the claimed invention appears to cover the scope of any substantial practical application utilizing any coefficients and formulas.

Please note that an issue of lack of tangibility has been raised for claims 37-54 in conjunction with the related rejection under 35 U.S.C. § 112, 2<sup>nd</sup> paragraph.

A new art rejection is also set forth below.

***Claim Objections***

3. Claim 3 is objected to because of the following informalities:

Claim 3, lines 4-5, delete "the user", insert -- a user --

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 37-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 37-54 recite that the interface is "configured to display at least a portion of the data..." and "capable of outputting the sustainability score." Similarly, these claims recite that a processor is "configured to compute the sustainability score..." The phrases "configured to" and "capable of" imply that the associated functionality may or may not be performed, thereby failing to clearly define the intended metes and bounds of the invention. The desired claim scope should be succinctly set forth and positively recited in order to clarify that these claims always perform the recited functionality (as opposed to just being capable of doing so).

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-54 and 56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statutory requirement of 35 U.S.C. § 101, a claimed invention must produce a useful, concrete, and tangible result. For a claim to be useful, it must yield a result that is specific, substantial, and credible (MPEP § 2107). A concrete result is one that is substantially repeatable, i.e., it produces substantially the same result over and over again (*In re Swartz*, 232 F.3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 2000)). In order to be tangible, a claimed invention must set forth a practical application that generates a real-world result, i.e., the claim must be more than a mere abstraction (*Benson*, 409 U.S. at 71-72, 175 USPQ at 676-77). Additionally, a claim may not preempt abstract ideas, laws of nature or natural phenomena nor may a claim preempt every “substantial practical application” of an abstract idea, law of nature or natural phenomena because it would in practical effect be a patent on the judicial exceptions themselves (*Gottschalk v. Benson*, 409 U.S. 63, 71-72 (1972)). (Please refer to the “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility” for further explanation of the statutory requirement of 35 U.S.C. § 101.)

Claims 37-54 recite that the interface is “capable of outputting the sustainability score.” Since the output is not positively recited or expressly performed, the tangible output is optional. The interface should expressly be recited as outputting the

sustainability score (and not just being capable of doing so) in order to clarify that these claims always produce a tangible result (as opposed to just being capable of doing so).

As per concreteness, since a human user enters the coefficient values, these coefficient values appear to be based on subjective data. The analysis of this subjective data is not consistently used to yield results that are substantially repeatable. In other words, the sustainability score is purely subjected to the potentially random opinions of users without any corresponding methodology to provide consistent significance to analysis of the sustainability score results. The specification states that the sustainability scores are used for benchmarking, yet each user randomly defines coefficients for factors that he/she feels to be important. If each user selects a different set of factors and corresponding coefficients, it is not clear that comparison of respectively yielded sustainability scores would be useful or significantly repeatable. Without any standard set for benchmarking, the resulting comparison would be inconsistent since it might be based on an apples and oranges comparison. The claimed invention does not expressly recite the significance of the sustainability score, thereby rendering such a score a mere abstraction.

Additionally, even if the sustainability score were determined to yield a practical application, the claimed coefficient values, non-economic factors, sustainability score, and related formula are recited so broadly and abstractly that the claimed invention could feasibly preempt every substantial practical application thereof, which is prohibited under 35 U.S.C. § 101.

Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-8, 12-54, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over CGSDI's Dashboard of Sustainability, as disclosed in the archived web site from [URL: [http://web.archive.org/web/\\*/http://esl.jrg.it/envind/dashbrds.htm](http://web.archive.org/web/*/http://esl.jrg.it/envind/dashbrds.htm)], archived between March 10, 2001 and February 13, 2003.

CGSDI's Dashboard of Sustainability discloses, in a computer-implemented rating system having access to a database populated with data concerning at least one non-economic factor for a company (Pages 22, 26-31, 36 -- A user can view countries of interest along with desired data related to the comparison of performance of these countries and their governments in the areas correlated to the issues of interest. The weighted issues are selected industries and a country and/or a country's government may be viewed as a company, which is defined by Merriam Webster's Collegiate® Dictionary (10<sup>th</sup> ed.) as being "a group of persons or things" or "an association of persons for carrying on a commercial or industrial enterprise"), a method comprising:

[Claim 1] providing an interface capable of displaying at least a portion of the data (Pages 26, 28-31);

enabling a user to input at least one coefficient value through the interface (Pages 8, 17, 18, 29 -- A user may input weights for the various evaluated issues);



associating each said coefficient value with a respective data concerning the at least one non-economic factor (Pages 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.);

computing a sustainability score using the at least one coefficient value and the data, the sustainability score utilizing the at least one non-economic factor in a formula that applies the associated coefficient value to the respective data concerning the at least one non-economic factor (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.; Pages 4, 26, 29, 32-34 -- Point values are assigned based on some function of the weighting, such as an average of all points or a linear interpolation of the values); and

outputting the sustainability score, the sustainability score defining a rating of the company which incorporates the at least one non-economic factor (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.; Pages 4, 26, 29, 32-34 -- Point values are assigned based on some function of the weighting, such as an average of all points or a linear interpolation of the values. These points values may be displayed on a screen; Pages 26-31, 36 -- A user can view countries of interest along with desired data related to the comparison of performance of these countries and their governments in the areas correlated to the issues of interest. The weighted issues are selected industries and a country and/or a country's government may be viewed as a company,

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which is defined by Merriam Webster's Collegiate® Dictionary (10<sup>th</sup> ed.) as being "a group of persons or things" or "an association of persons for carrying on a commercial or industrial enterprise");

[Claim 2] storing the user-input coefficient value in an account associated with the user (Pages 26-27, 37-38 -- A user may store and/or export the information to a file or to an online dashboard community);

[Claim 12] wherein the sustainability score includes a plurality of individual scores corresponding to discrete sustainability criteria (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.; Pages 4, 26, 29, 32-34 -- Point values are assigned based on some function of the weighting, such as an average of all points or a linear interpolation of the values. These points values may be displayed on a screen);

[Claim 13] wherein the coefficient value is used to compute at least one of the individual scores (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.; Pages 4, 26, 29, 32-34 -- Point values are assigned based on some function of the weighting, such as an average of all points or a linear interpolation of the values. These points values may be displayed on a screen);

[Claim 14] wherein the sustainability score is computed by combining at least two of the individual scores (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.; Pages 4, 26, 29, 32-34 -- Point values are assigned based on some function

of the weighting, such as an average of all points or a linear interpolation of the values.

These points values may be displayed on a screen); and

the coefficient value is used to affect how the individual scores are combined (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.; Pages 4, 26, 29, 32-34 -- Point values are assigned based on some function of the weighting, such as an average of all points or a linear interpolation of the values. These points values may be displayed on a screen);

[Claim 15] wherein the discrete sustainability criteria include at least one of a social responsibility rating, an environmental responsibility rating, and a corporate governance rating (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc. This information may be used to assess a country and its government, as seen on pages 2, 7, and 13);

[Claim 16] wherein the discrete sustainability criteria further include an economic rating (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.);

[Claim 17] benchmarking the sustainability score against a reference score (Pages 26-31, 36 -- A user can view countries of interest along with desired data related to the comparison of performance of these countries and their governments in the areas correlated to the issues of interest; Page 25 -- Color coding is used to indicate a relative performance);

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[Claim 18] wherein the data concerns non-economic factors for multiple governments (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.; Page 5 -- Countries can be compared side by side; Pages 26-31, 36 -- A user can view countries of interest along with desired data related to the comparison of performance of these countries and their governments in the areas correlated to the issues of interest);

the interface further enables the user to select one of the governments (Pages 26-31, 36 -- A user can view countries of interest along with desired data related to the comparison of performance of these countries and their governments in the areas correlated to the issues of interest); and

computing uses the data concerning the selected one of the governments (Pages 26-31, 36 -- A user can view countries of interest along with desired data related to the comparison of performance of these countries and their governments in the areas correlated to the issues of interest).

Regarding claim 1, CGSDI's Dashboard of Sustainability computes a global index value for each country and/or each country's government (Pages 4, 26, 29, 32-34 -- Point values are assigned based on some function of the weighting, such as an average of all points or a linear interpolation of the values), yet it does not expressly disclose that the user is permitted to view the formula through the interface. This difference is only found in the non-functional descriptive material and is not functionally involved in the steps recited nor does it alter the recited structural elements; therefore,

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such a difference does not effectively serve to patentably distinguish the claimed invention over the prior art. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Nevertheless, CGSDI's Dashboard of Sustainability allows a user to "see how the country rankings change when you fumble with indicator weights, move an indicator into another index, or apply smoothing to an indicator." Additionally, a user may assign weights to the various issues (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.); therefore, a user can affect how countries compare to one another and the resulting display by altering some of the elements of the formula used in a selected form of comparison. Official Notice is taken that it is old and well-known in the art of graphical user interfaces to display to a user any information that is deemed important for the user's quick and readily comprehensible understanding of conveyed subject matter. Since CGSDI's Dashboard of Sustainability allows users to have some control over how countries are benchmarked against one another and over how such data is displayed for each user's personal convenience, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify CGSDI's Dashboard of Sustainability to present the formula through the interface to the user in order to

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facilitate the user's more quick and readily comprehensible understanding of conveyed subject matter by reminding the user which formula and corresponding weights he/she has selected and how such changes can affect each country's comparison to other countries.

CGSDI's Dashboard of Sustainability discloses, in a computer-implemented rating system having access to a database populated with data concerning at least one non-economic factor for multiple companies (Pages 22, 26-31, 36 -- A user can view countries of interest along with desired data related to the comparison of performance of these countries and their governments in the areas correlated to the issues of interest. The weighted issues are selected industries and a country and/or a country's government may be viewed as a company, which is defined by Merriam Webster's Collegiate® Dictionary (10<sup>th</sup> ed.) as being "a group of persons or things" or "an association of persons for carrying on a commercial or industrial enterprise"), a method comprising:

[Claim 3] providing an interface capable of displaying at least a portion of the data (Pages 26, 28-31) and enabling the user to select at least one of the industry and a company within the industry (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.; Page 5 -- Countries can be compared side by side; Pages 26-31, 36 -- A user can view countries of interest along with desired data related to the comparison of performance of these countries and their governments in the areas correlated to the

issues of interest. The weighted issues are selected industries and a country and/or a country's government may be viewed as a company, which is defined by Merriam Webster's Collegiate® Dictionary (10<sup>th</sup> ed.) as being "a group of persons or things" or "an association of persons for carrying on a commercial or industrial enterprise");

accepting at least one user-input coefficient value through the interface (Pages 8, 17, 18, 29 -- A user may input weights for the various evaluated issues);

associating each said coefficient value with a respective data concerning the at least one non-economic factor for a company (Pages 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.);

computing a sustainability score using at least one of said coefficient value and the data concerning the selected one of the companies, the sustainability score utilizing the at least one non-economic factor in a formula (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.; Pages 4, 26, 29, 32-34 -- Point values are assigned based on some function of the weighting, such as an average of all points or a linear interpolation of the values); and

outputting the sustainability score, the sustainability score defining a rating of the industry or company within the industry incorporating the at least one non-economic factor (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.; Pages 4, 26, 29, 32-34 -- Point values are assigned based on some function of the

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weighting, such as an average of all points or a linear interpolation of the values. These points values may be displayed on a screen);

[Claim 4] wherein the sustainability score for an industry is computed from data concerning non-economic factors of companies in the industry (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.).

Regarding claims 3 and 5, CGSDI's Dashboard of Sustainability computes a global index value for each country and/or each country's government (Pages 4, 26, 29, 32-34 -- Point values are assigned based on some function of the weighting, such as an average of all points or a linear interpolation of the values), yet it does not expressly disclose that the user is permitted to view the formula through the interface. This difference is only found in the non-functional descriptive material and is not functionally involved in the steps recited nor does it alter the recited structural elements; therefore, such a difference does not effectively serve to patentably distinguish the claimed invention over the prior art. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP § 2106. Nevertheless, CGSDI's Dashboard of Sustainability allows a user to "see how the country rankings change when you fumble



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with indicator weights, move an indicator into another index, or apply smoothing to an indicator.” Additionally, a user may assign weights to the various issues (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.); therefore, a user can affect how countries compare to one another and the resulting display by altering some of the elements of the formula used in a selected form of comparison. Official Notice is taken that it is old and well-known in the art of graphical user interfaces to display to a user any information that is deemed important for the user’s quick and readily comprehensible understanding of conveyed subject matter. Since CGSDI’s Dashboard of Sustainability allows users to have some control over how countries are benchmarked against one another and over how such data is displayed for each user’s personal convenience, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to modify CGSDI’s Dashboard of Sustainability to present the formula through the interface to the user in order to facilitate the user’s more quick and readily comprehensible understanding of conveyed subject matter by reminding the user which formula and corresponding weights he/she has selected and how such changes can affect each country’s comparison to other countries.

As per claims 6-8, CGSDI’s Dashboard of Sustainability does not expressly disclose where all of its data comes from; however, it suggests that data sets are utilized, such as those submitted by users (Page 23). Regarding claim 6 in particular, CGSDI’s Dashboard of Sustainability does not expressly disclose the steps of

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subsequently receiving later data concerning at least one non-economic factor for a company and computing a subsequent sustainability score for the company using the later data; however, Official Notice is taken that it is old and well-known in the art of data analysis and benchmarking to update one's source of data as new data becomes available. This helps to ensure that resulting calculations are as accurate as possible since they are based on updated data. Since the success of CGSDI's Dashboard of Sustainability relies on the ability to accurately analyze sustainability issues, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify CGSDI's Dashboard of Sustainability to perform the steps of subsequently receiving later data concerning at least one non-economic factor for a company and computing a subsequent sustainability score for the company using the later data (claim 6) in order to help to ensure that resulting calculations are as accurate as possible by basing them on updated (i.e., recent) data. Regarding claims 7 and 8, since CGSDI's Dashboard of Sustainability suggests that data sets, such as those submitted by users, are utilized to perform its analysis (Page 23), it is important to verify the accuracy of these data sets in order to ensure greater confidence in the accuracy of the resulting analysis. Additionally, Official Notice is taken that it is old and well-known in the art of entity evaluation to gather feedback from the entity itself or the general public. Such a practice promotes an assessment of the entity's performance in a more 360 degree fashion, thereby providing differing viewpoints for a more comprehensive analysis. Again, since the success of CGSDI's Dashboard of Sustainability relies on the ability to accurately analyze sustainability

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issues, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify CGSDI's Dashboard of Sustainability such that the later data is received from at least one of the public and the company (claim 8) (or both the public and the company) in order to promote an assessment of the country's or the country's government's performance in a more 360 degree fashion, thereby providing differing viewpoints for a more comprehensive analysis. The Examiner also submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify CGSDI's Dashboard of Sustainability to wait to receive a verification flag respecting the later data prior to computing the subsequent sustainability score (claim 7) in order to verify the accuracy of submitted data sets to further ensure greater confidence in the accuracy of the resulting analysis, which is especially important when data collected from the public and the company may be biased.

[Claims 19-54, 56] Claims 19-54 and 56 recite limitations already addressed by the rejection of claims 1-8 and 12-18 above; therefore, the same rejection applies.

Furthermore (regarding claims 28 and 46), CGSDI's Dashboard of Sustainability recites limitations already addressed by the rejection of claims 6 and 8 above; therefore, the same rejection applies. Furthermore, Official Notice is taken that it is old and well-known in the art of data gathering to collect data in the form of a response to a questionnaire. Such a practice facilitates that responses are given in a desired format for more simple processing of the responses. For the reasons presented in reference to

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claims 6 and 8 above, the Examiner further submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify CGSDI's Dashboard of Sustainability such that the later data is received as a response to a questionnaire (claims 28 and 46) in order to facilitate that responses are given in a desired format for more simple processing of the responses.

Furthermore (regarding claims 29 and 47), CGSDI's Dashboard of Sustainability allows a user to store and/or export the information to a file or to an online dashboard community (Pages 26-27, 37-38), yet it does not expressly teach the step of establishing a secure entity reporting channel, wherein the later data is received over the channel. However, Official Notice is taken that it is old and well-known in the art of data sharing to do so via a secure entity reporting channel. Such a practice helps to protect the integrity of sensitive data. Since CGSDI's Dashboard of Sustainability deals with potentially sensitive data or analysis thereof, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify CGSDI's Dashboard of Sustainability to establish a secure entity reporting channel, wherein the later data is received over the channel (claims 29 and 47) in order to help protect the integrity of the gathered data and resulting analyses.

10. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over CGSDI's Dashboard of Sustainability, as disclosed in the archived web site from [URL: [http://web.archive.org/web/\\*/http://esl.jrg.it/envind/dashbrds.htm](http://web.archive.org/web/*/http://esl.jrg.it/envind/dashbrds.htm)], archived between

March 10, 2001 and February 13, 2003, as applied to claim 6 above, in view of

"Nedbank Launches Sustainable Investment Index Fund."

[Claim 9] CGSDI's Dashboard of Sustainability discloses that the data concerns non-economic factors for multiple companies (Pages 4, 8, 17, 18, 29 -- A user may input weights for the various evaluated issues, which include issues regarding the economy, environment, social care, etc.), yet CGSDI's Dashboard of Sustainability does not expressly disclose the steps of defining a derivative index product comprising a selection of companies among the multiple companies, pricing the derivative product, and offering the derivative product for purchase and sale in a public market (claim 9). However, "Nedbank Launches Sustainable Investment Index Fund" discloses an index of funds of "large companies that subscribe to international best practices on sustainable development." The index was developed by Edward Nathan & Friedland and "weights companies using their weighting in the FTSE/JSE Top 40 index and their sustainability score reflecting their compliance with international best practices on sustainable development." It is also old and well-known in the art of investment that an index of funds may include a derivative product that is priced and sold. Since CGSDI's Dashboard of Sustainability establishes a similar index that compares entities based on their respective sustainability, the Examiners submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify CGSDI's Dashboard of Sustainability to be adapted to be used in conjunction with an investment environment that includes the steps of defining a derivative index product comprising a selection of companies among the multiple companies, pricing the derivative product,

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and offering the derivative product for purchase and sale in a public market (claim 9) in order to encourage financial investment in entities, including countries and their governments, that promote sustainable development, thereby strengthening positive sustainable development practices worldwide.

[Claim 10] CGSDI's Dashboard of Sustainability recites limitations already addressed by the rejection of claims 6 and 8 above; therefore, the same rejection applies.

Furthermore, Official Notice is taken that it is old and well-known in the art of data gathering to collect data in the form of a response to a questionnaire. Such a practice facilitates that responses are given in a desired format for more simple processing of the responses. For the reasons presented in reference to claims 6 and 8 above, the Examiner further submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify CGSDI's Dashboard of Sustainability such that the later data is received as a response to a questionnaire (claim 10) in order to facilitate that responses are given in a desired format for more simple processing of the responses.

[Claim 11] CGSDI's Dashboard of Sustainability allows a user to store and/or export the information to a file or to an online dashboard community (Pages 26-27, 37-38), yet it does not expressly teach the step of establishing a secure entity reporting channel, wherein the later data is received over the channel. However, Official Notice is taken that it is old and well-known in the art of data sharing to do so via a secure entity reporting channel. Such a practice helps to protect the integrity of sensitive data. Since CGSDI's Dashboard of Sustainability deals with potentially sensitive data or analysis

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thereof, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to modify CGSDI's Dashboard of Sustainability to establish a secure entity reporting channel, wherein the later data is received over the channel (claim 11) in order to help protect the integrity of the gathered data and resulting analyses.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

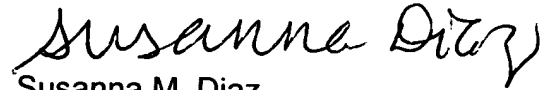
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink that reads "Susanna Diaz". The signature is written in a cursive, flowing style.

Susanna M. Diaz  
Primary Examiner  
Art Unit 3694

December 26, 2006